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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,026	09/03/1999	CHARLES A. PEYSER	020748.0103PTUS	6211
IP Department Patton Boggs, LLP Suite 3000 2001 Ross Avenue Dallas, TX 75201				
7590 05/18/2009				
EXAMINER				
GARG, YOGESH C				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
05/18/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/390,026

**Applicant(s)**

PEYSER ET AL.

**Examiner**

Yogesh C. Garg

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39, 45, 46, 54, 55, 58 and 60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39, 45, 46, 54, 55, 58 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. Amendment filed 2/18/2009 is entered. Claims 39, 45-46, 54, 58 and 60 are currently amended. Claims 1-38 were previously canceled. Claims 40-44, 47-53, 56-57 and 59 were previously withdrawn. Claims 39, 45-46, 54-55, 58 and 60 are currently pending.

### ***Response to Arguments***

2. Applicant's arguments filed 2/18/2009 have been fully considered but they are not persuasive. The applicant has argued and stated the following:

*" both Walker and Bell fail to teach, suggest or disclose receiving prior use data from a buyer during purchase of telecommunication services. Therefore, Applicants respectfully submit, that even if "it would have been obvious to [one of] ordinary skill in the art at the time the invention was made to combine the above teaching of Walker with Bell," (Office Action at page 6), which it is not, the result would fail to teach all of the limitations recited in the independent claims of the present invention. " (see page \*)*

*" Walker fails to teach, suggest or disclose "generating an offer to provide the at least one telecommunication service to the buyer in response to receiving ... the information [regarding prior use of telecommunication services by the buyer]" which occurs during the purchase of telecommunications services as disclosed by amended claim 39 of the present invention." (see pages 7-8), and*

*"Bell uses a customer's prior purchase history to determine the creditworthiness of customer rather than using this information to tailor offerings of telecommunication services to customer as recited by claim 39 of the present invention." .*

The examiner respectfully disagrees for the following reasons:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *receiving prior use data from a buyer during purchase of telecommunication services.*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 39 does not specifically recite the time of receiving prior use of data from a buyer that it is received during purchase. The limitation "receiving information from the buyer regarding prior use of telecommunication services from the buyer", does not necessarily mean receiving this information during purchase of a particular order. The information from the buyer regarding prior use of telecommunication service can be either currently received by one of the well-known practices [which are well within the objective reach of an ordinary skilled in the art] via a survey session with the buyer or questioning the buyer or previously received and stored in a database. Even if the claim is amended to include the limitation "during purchase", the timing does not affect the patentability because it is the step of receiving information regarding the buyer's prior use of telecommunication services irrespective of the fact when the information is received that is earlier or at the time of the order or from whom that is from the buyer directly or from a third party. A buyer of telecommunication services such as long distance services will be an existing user of telecommunication services from a local company and then can further purchase long distance services from other carriers at a discount. In order to provide long distance services to the buyer it would be required to know his existing local

telecommunication service provider and his existing telephone number, as shown in Walker, see col.8, lines 14-18, col.8, line 59-col.9, line 7 and fig.4. In fig.4 information from the buyer about his prior use of telecommunication services from local operators such as "SNET" or "NYMEX" and the buyer's telephone number is received and only after receiving/knowing this information about prior use of telecommunication service of the buyer it will be possible to generate and make offers for long distance services to the buyer.

The applicant argues, see pages 8-10, that in Walker's CPO technique the power of acceptance resides with seller and that in his invention the power of acceptance always resides with the buyer and further Walker is silent about communicating counter from the CPO to the buyer and therefore Walker does not teach all the limitations of claim 39. The examiner respectfully disagrees. Walker does teach countering a CPO on behalf of seller (see col.6, lines 37-) which to one of an ordinary skilled in the art will clearly mean that the transaction is still open and can only be concluded subject to the buyer's response by either stating his acceptance to the counter or rejection to the seller's counter.

The applicant further argues that Walker does not teach the newly added limitation that is "receiving a plurality of questions from the buyer, the questions being associated with a provider of telecommunication services". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck &*

*Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, Walker does not teach this limitation but Bell (see pages 1-3) does teach this limitation. In view of Bell, it would be obvious to one of an ordinary skilled in the art to have modified Walker to include this feature of receiving a plurality of questions from the buyer, the questions being associated with a provider of telecommunication services because users do ask some questions frequently about the scope of telecommunication service to be provided by a provider, as shown in Bell.

In view of the foregoing, rejections of currently amended claims 39, 45-46, 54-55, 58 and 60 is sustainable in view of Walker and Bell.

3 Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other relevant and related passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the other relevant and related passages and figures in the cited references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 39, 45-46, 54-55, 58 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of the published article, " Bell offers Answers for Commonly Asked Customer Questions"; Anonymous; St Louis Business Journal (St Louis, MO US), v7 N26 s3 p1c; March 23, 1987 extracted from Dialog File 635; hereinafter referred to Bell.

With regards to claim 39, Walker discloses a system for purchasing telecommunication services from a plurality of sellers, the system comprising:

a server in communication with a buyer terminal and a plurality of seller terminals, wherein the server performs a method stored in a storage medium and executed by one or more processors (see at least figs.1b and 3. CPO management system "100" represents the server in communication with a buyer terminal "115" and seller terminals " 120, 121, 122 and 123") comprising;

receiving one or more requests for purchasing at least one telecommunication service at a server, the request being associated with a buyer (see at least FIG.1a, ' Calling party 110 " represents. buyers' terminals wherein each buyer can send one or more requests [see at least col.1, lines 28-32 and col.2, lines 62-66 wherein the buyers can request services for one or more long distance telephone service/telephone calls] to a CPO management system 100 [see also Fig.3] representing the sever which is requested for the required long distance telephone services/requests by the buyer, and " Inter exchange carrier 1, 2....N" correspond to different providers of long distance telephone services.);

receiving information from the buyer regarding prior use of telecommunication services of the buyer ( The limitation "receiving information from the buyer regarding prior use of telecommunication services from the buyer", neither recites receiving this information during purchase of a particular order nor recites as how it is obtained. The information from the buyer regarding prior use of telecommunication service can be either currently received by one of the well-known practices [which are well within the objective reach of an ordinary skilled in the art] via a survey session with the buyer or questioning the buyer or previously received and stored in a database. Even if the claim is amended to include the limitation" during purchase", the timing does not affect the patentability because it is the step of receiving information regarding the buyer's prior use of telecommunication services irrespective of the fact when the information is received that is earlier or at the time of the order or from whom that is from the buyer directly or from a third party. A buyer of telecommunication services such as long distance services will be an existing user of telecommunication services from a local company and then can further purchase long distance services from other carriers at a discount. In order to provide long distance services to the buyer it would be required to know his existing local telecommunication service provider and his existing telephone number, as shown in Walker , see col.8, lines 14-18, col.8, line 59-col.9, line 7 and fig.4. In fig.4 information from the buyer about his prior use of telecommunication services from local operators such as "SNET" or "NYMEX" and the buyer's telephone number is received and only after receiving/knowing this information about prior use of



telecommunication service of the buyer it will be possible to generate and make offers for long distance services to the buyer.);

generating an offer to provide the at least said telecommunication service to the buyer in response to receiving the one or more requests and receiving the information, the offer being associated with a provider of said telecommunication services, receiving a response to the offer, wherein the response is associated with the buyer, wherein the response may be an acceptance of the offer or a rejection of the offer and notifying the provider of the response and an identity of the buyer (see at least FIG.1a, ' Calling party 110 " represents. buyers' terminals wherein each buyer can send one or more requests [see at least col.1, lines 28-32 and col.2, lines 62-66 wherein the buyers can request services for one or more telephone calls], CPO management system 100 [see also Fig.3] represents the sever which is requested for the required services/requests by the buyer, and " Inter exchange carrier 1, 2....N" correspond to different providers of services, col.4; tines 39-52, receiving and processing CPOS for telephone calls from one or more calling parties, such as a calling party 110... ;and col.6, line 84-col.7, firm 9 , " ... Figs. 8a and 1b, to provide (i) each CPO to the inter exchange carriers 120... ...". Also see col.3, lines 8-67. Walker discloses that on receiving the information about the prior use of telecommunication services [information about using SNET or NYMEX, see fig.4] and responses from the number of inter exchange carriers, that is the service providers, the buyer is notified about the offers and if the buyer accepts an offer the contract is completed, that is the seller is informed and services accepted from the seller for said buyer and payment made, which implies notifying the identity of the

buyer. Walker's system/method further includes the feature of providing a counter offer in response to the buyer's CPO , see col.6, lines 37-42, " *Thus, the CPO management system 100 can determine if one or more carriers accepts a given CPO by providing the CPO to each carrier and receiving an acceptance or rejection, or by applying the CPO to the CPO rules to render a decision to either accept, reject or counter a CPO on behalf of a particular carrier.* By sending a counter offer to the buyer inherently it will be either accepted by the buyer or rejected by the buyer and the buyer's response would be notified to the provider. Also see col.7, lines 15-33 which suggests that a buyer on receiving the provider's offer can either complete his call that implying accepting the provider's offer or may nor complete the call that implying rejecting the provider's offer.);

Walker teaches verifying the identity of the buyer from a plurality of data sources (see figs.4 and 7 and paragraphs 23 and 28. Customer's ID that is his telephone number can be verified from databases 400 and 700. The stored telephone number Information in databases 400 and 700 is used as a customer identifier to index a historical database correspond to receiving Information about prior use of telecommunication services of the users/buyers).

Walker does not explicitly teach receiving a plurality of questions from the buyer, the questions being associated with a provider of telecommunication service. Bell, in the same field of endeavor, discloses using prior use information from the customer/buyer in redesigning and improving the services and products offered to the buyer/customer, see at least page 2, paragraph beginning "A: Usually, no. Customers may be asked for a deposit if they have had prior credit problems with the telephone company. The amount of deposit for a new applicant would be twice the average monthly bill for all

residential applications". Bell teaches obtaining information from the buyers about the prior telephone service usage and using that information in generating offers that is asking for a deposit if the customer had prior credit problems with the telephone company . Bell also teaches receiving a plurality of questions from the buyer, the questions being associated with a provider of telecommunication service, see pages 1-3. In view of Bell , it would be obvious to one of an ordinary skilled in the art to have modified Walker to include this feature of receiving a plurality of questions from the buyer, the questions being associated with a provider of telecommunication services because users do ask some questions frequently about the scope of telecommunication service to be provided by a provider, as shown in Bell.

Regarding claims 45 and 46, their limitations are already covered in the analysis of claim 39 above (see Bell at least page 2, paragraph beginning "A: Usually, no. Customers may be asked for a deposit if they have had prior credit problems with the telephone company. ).

Regarding claims 54, 58 and 60 their limitations are closely parallel to the limitations analyzed for claim 39 and are therefore analyzed and rejected on the basis of same analysis and rationale set forth for claim 39 above.

Regarding claims 55, Walker discloses a database in communication with the server (see fig.3. Data storage device 330 in communication with server 300 wherein

the database device 330 can store buyer's requests [CPO], buyer data, qualification data and seller data [carrier] and any other relevant information can be stored and used ).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hoffman et al. (US 20040020982 A1, see at least paragraphs 74, 414 and 596) teaches verifying/validating identity of a user from a plurality of databases by comparing with stored Individual biometric database records, PIN codes, SSN and other related information.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yogesh C Garg/  
Primary Examiner, Art Unit 3625